

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION AT DAYTON**

PAXAR AMERICAS, INC.,

Plaintiff,

-vs-

ZEBRA TECHNOLOGIES
CORP., et al.,

Defendants.

:

Case No. 3:03-cv-142

:

District Judge Walter Herbert Rice
Chief Magistrate Judge Michael R. Merz

:

**DECISION AND ORDER GRANTING IN PART AND DENYING IN PART
DEFENDANTS' MOTION TO COMPEL**

This case is before the Court on Defendants' Motion to Compel Production of Documents and Deposition Testimony (Doc. No. 114) which Plaintiff opposes (Doc. No. 125) and as to which Defendants have filed a Reply Memorandum (Doc. No. 137).

Documents Related to Non-Issued Foreign Patent Applications

In the first branch of its Motion, Zebra¹ seeks production of documents pertaining to non-issued foreign patent applications that cover the same inventions as the patents-in-suit. Zebra has adequately explained the potential relevance of these documents to the claims and defenses in the case.

Paxar asserts this branch of the Motion is moot because it has produced the requested

¹Defendants are collectively referred to herein as "Zebra."

documents already (Opposition, Doc. No. 125, at 1-2.) It claims that Zebra's request was limited to "non-pending foreign patent applications that claimed direct priority to the patents-in-suit" during a telephone conversation among counsel on April 7, 2005. The confirming correspondence between counsel does not show agreement on any such limitation.

Because the documents in question were properly requested long ago and are potentially relevant to the claims and defenses in the case, Paxar is ordered to produce the referenced documents not later than September 10, 2005.

A Rule 30(b)(6) Witness Regarding Relevant Foreign Patent Applications

On March 11, 2005, Zebra served a notice of deposition under Fed. R. Civ. P. 30(b)(6) seeking deposition testimony on "[t]he identity and prosecution of all foreign patents and patent applications corresponding or related to the Paxar Patents." (Motion, Doc. No. 114, at 3.) Paxar asserts that this request is also moot because it produced Donald Morrison as a Rule 30(b)(6) witness on Topic No. 5 of the referenced deposition notice. (Opposition, Doc. No. 125, at 3.) Zebra's Reply Memorandum (Doc. No. 137 at 6-7) demonstrates that Morrison's testimony was limited by Paxar more narrowly than the request.

Because the request was timely made and the testimony sought is potentially relevant to the claims and defenses in the case, Paxar is ordered to produce Donald Morrison for the reopening of Paxar's 30(b)(6) deposition on Topic 5 in Zebra's Second Notice of Rule 30(b)(6) Deposition.

Discovery Pertaining to the Prosecution of the Patents-in-Suit

Also on March 11, 2005, Zebra issued subpoenas duces tecum to Joseph Grass and

McAndrews, Held & Malloy, Paxar's trial counsel in this case. The categories of documents sought by the subpoenas are exceptionally broad (See Exhibits 10 and 11 to Doc. No. 114) and Paxar objected to the subpoenas in their entirety. Paxar now asserts that the first time Zebra narrowed the scope of the requests was in the Motion to Compel itself (See Opposition, Doc. No. 125, at 4.) Zebra tacitly admits the truth of this assertion by claiming "Paxar's Opposition, however, provides no substantive basis for its refusal to comply with Zebra's discovery requests regarding the prosecution of the patents-in-suit. Therefore, this Court should issue the requested order." (Reply Memorandum, Doc. No. 137, at 8.)

On the contrary, the Court concludes that this branch of the Motion should not be granted because Zebra did not make reasonable efforts to resolve this discovery dispute before filing the Motion to Compel, as is required by Fed. R. Civ. P. 37(a)(2)(B) and S. D. Ohio Civ. R. 37.1 and 37.2.

Conclusion

Branches 1 and 2 of Zebra's Motion to Compel are granted; branch 3 is denied.

August 29, 2005.

s/ **Michael R. Merz**
Chief United States Magistrate Judge